REMARKS

There are now pending in this application Claims 1, 3, 4, 7, 9-12, 27-29, 31-33, 38, and 42-53, with Claims 1, 27-29, 31, 38, 42, 46, 48, and 51 being the independent claims. Claims 42, 46, 48, and 51 have been amended. No claims have been added or cancelled.

In the Official Action, dated April 22, 2003, Claims 1, 3, 4, 7, 9-12, 22, 27-29, 31, 38, and 42-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029, 182 (Nehab, et al.) in view of U.S. Patent No. 5,796,952 (Davis, et al., et al.) . Claims 32 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nehab, et al., in view of Davis, et al., and further in view of U.S. Patent No. 5,633,996 (Hayashi, et al.). Reconsideration and withdrawal of these aforementioned rejections are respectfully requested in view of the above-amendments and the following remarks.

Claim 1 relates to a method, operable in a first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents. The method comprises the steps of monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents; accessing the plurality of hyper-text documents including formatting information of the accessed hyper-text documents; compiling a list of the plurality of accessed hyper-text documents using the formatting information; fetching the plurality of accessed hyper-text documents compiled to the list; and formatting the plurality of fetched hyper-text documents using the formatting information into the single continuous printable document in which at least one fetched hyper-text document is spatially contiguously followed by another fetched hyper-text document on the same page of the single continuous printable document.

The cited art fails to disclose or suggest the above-mentioned features of the present invention. In particular, the cited art fails to disclose or suggest a method, operable in a first application upon a local machine, of forming a single continuous printable document by collating a plurality of hyper-text documents using several steps, including, inter alia, monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents.

The Nehab, et al. patent relates to a system for generating a custom formatted hypertext document by using a personal profile to retrieve hierarchical documents. However, this patent fails to disclose or suggest monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents, as claimed in Claim 1.

The Davis, et al. patent relates to a method for monitoring client interaction with a network resource and creating client profiles and a resource database. However, this patent fails to disclose or suggest monitoring a second application operating independently of the first application on the local machine, to identify access patterns of the second application to the plurality of hyper-text documents, as claimed in Claim 1.
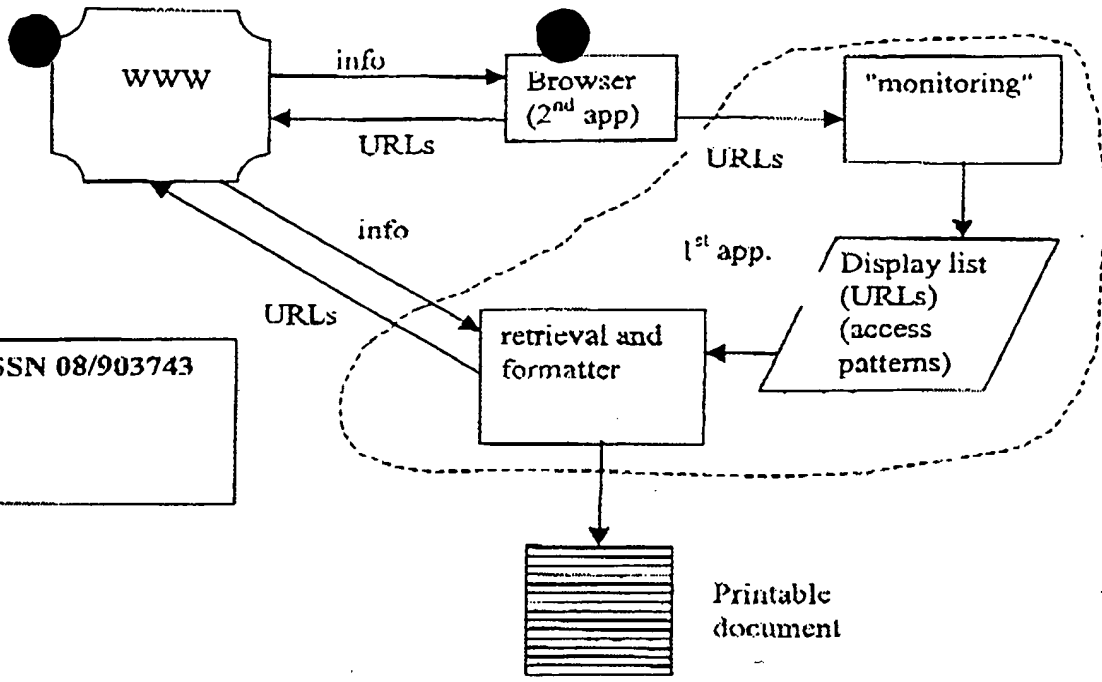
In Davis, et al., the user using a browser accesses a resource from a network such as the World Wide Web. Upon accessing the particular resource, the server providing the resource also delivers to the user a monitoring program which monitors the user's interaction with the resource. The monitoring program returns information to the server by which the server may determine other resources of preference that may be subsequently delivered to the user. Applicants submit that in the arrangement described in the Davis, et al. patent, the monitoring program is associated with the particular resource delivered to the client via the server. The

server, being the provider of both the resource and the monitoring program, can tailor the monitoring program to operate in concert with the resource. Accordingly, the monitoring program and the delivered resource are not independent of one another, but rather are linked to one another.
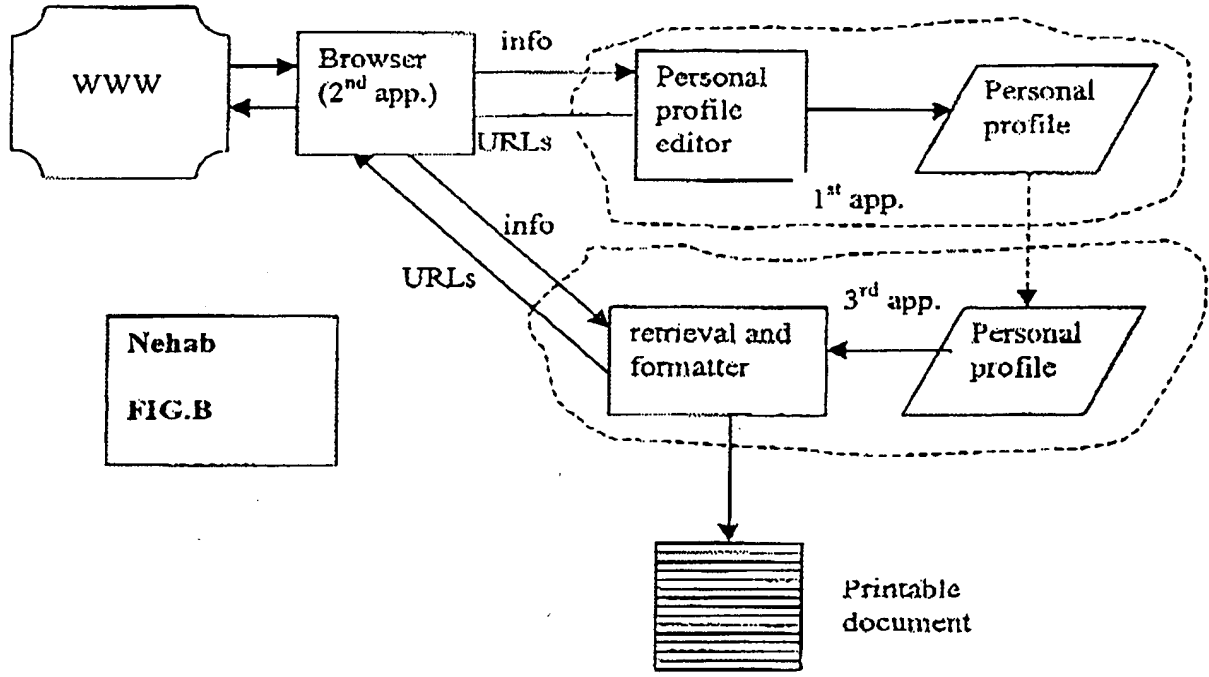
Applicants submit that these distinctions may also be illustrated with reference to Figures A-D which have been prepared by the Applicants. Figure A is representative of the present invention. Applicants submit that Figure B is representative of Nehab, et al., and Figure C is representative of the Davis, et al. patent. While Applicants submit that it is inappropriate to combine Nehab, et al. with Davis, et al., for the sake of responding to the assertions in the Official Action, Figure D is representative of the combination of Nehab, et al. and Davis, et al.

WWW → info → Browser (2nd app) → URLs → "monitoring"

URLs → info

1st app.

retrieval and formatter ← Display list (URLs) (access patterns)

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FIG. A

→ Printable document

WWW → Browser (2nd app.) → info → Personal profile editor → Personal profile

URLs

1st app.

info

URLs

3rd app.

retrieval and formatter ← Personal profile

Nehab

FIG.B

→ Printable document

WWW →info→ Browser (2nd app) →URLs→ Tracker (1st app)

←URLs←

Web server (3rd app.) | historic user profile

Davis

FIG. C

WWW →info→ Browser (2nd app) →URLs→ Tracker + Personal profile editor (1st app)

←URLs←

URLs | info

Nehab + Davis

FIG. D

3rd app.
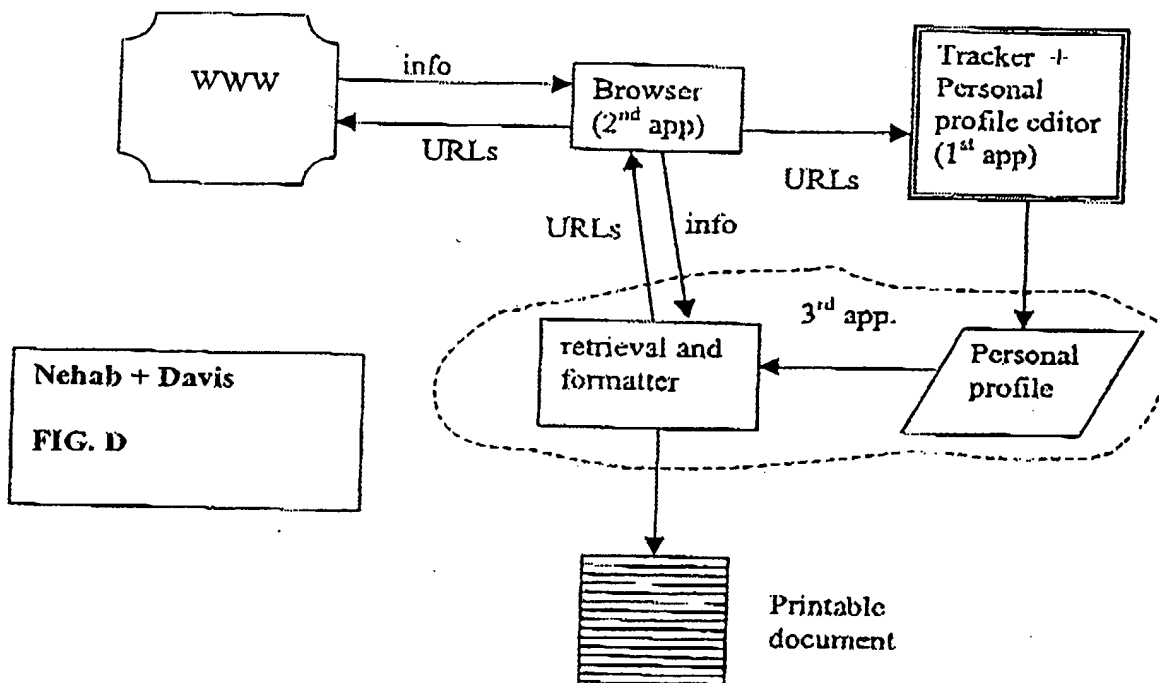
retrieval and formatter ← Personal profile
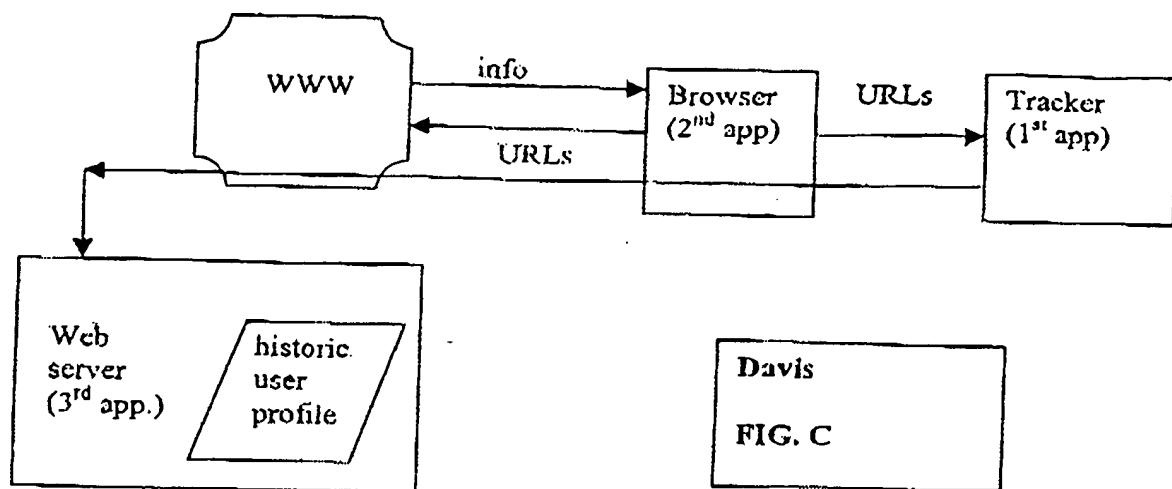
Printable document

Fig. A illustrates a browser (the "second application") that accesses the worldwide web. A first application includes a monitoring stage which monitors URL's from the browser application and which creates the display list of URL's accessed by the browser application. The display list then provides an "on-the-fly" input to a document retrieval and formatter module that interfaces directly with the worldwide web to access information using the supplied URL's from the display list and to produce a printable document.

In contrast, as seen in Fig. B, while Nehab, et al. discloses a program, such program has two distinct application functions. Nehab, et al. discloses a personal profile editor module (a "first" application) which is invoked by a user to enable the user to establish a particular personal profile of web locations desired by the user to be routinely accessed. The personal profile editor accesses the Web via browser (the "second" application). In Nehab, et al., this is for the purpose of creating an electronic newspaper effectively customized to the user's preferences of source information. As with all periodical documents, the purpose is to establish those specific sources in which the user has interest so that such can be routinely relied upon to create a newspaper document for perusal.

Once the personal profile of Nehab, et al. has been obtained, as determined under another application function (a "third "application), the personal profile is used as an input with the retrieval and formatter module which then retrieves the information contained at the URL's established in the profile, and then produces a printable document as output. Significantly, and in contrast to the present application, in Nehab, et al., the personal profile is established by the user according to user's preferences. Once the personal profile is established, it remains fixed until such time as it is subsequently edited by the user. Further Nehab, et al. fails to disclose or

suggest the "monitoring" step and in particular the monitoring by a first application of a second (browser) application by which the user may traverse the worldwide web.

Figure C conceptualizes the Davis, et al. patent which discloses an arrangement by which a user accesses particular sites on the worldwide web using a browser (the "second") application. Upon accessing certain websites, a tracker program (the "first" application) is downloaded from the website to the local machine and remains resident on that local machine to monitor or track those sites the user of the browser accesses during a particular web session. Most notably, the tracker program described in Davis, et al. (see, column 14) forms no function upon the local machine that is of any value to the user of that machine. As clearly described in column 14 of Davis, et al., the tracker program returns information through the browser and to a web server (a "third "application) in order to obtain a historic user profile. The purpose of that user profile is to enable a person operating the web server to provide web-based advertisements to the user that are, in some way, linked to the user's previous web browsing history. For example, a user based in the United States who accesses information regarding the Greek isles could subsequently receive advertisements for Mediterranean holiday packages.

As a consequence, in terms of the operation of the local machine as referred to in the Davis, et al. patent, the tracker application produces no specific result or utility for the user of that local machine. The tracker application of Davis, et al. starkly contrasts both the arrangement in the present application and the arrangement of Nehab, et al. where the local application (the first application of the present invention or the 1st and 3rd applications of Nehab, et al.) at least achieves a result that is specifically designated by the user.

Since Davis, et al. is unrelated to generating any specified result for the user at the user location, Applicants submit that there is no teaching or suggestion that would suggest to a

person skilled in the art that the Davis, et al. patent should be combined with the Nehab, et al. patent to achieve the present invention.

Nevertheless, for the sake of argument, Fig. D is provided representing the Applicants' best efforts to conceptualize a combination of Nehab, et al. and Davis, et al. In Fig. D the tracker program has been identified as a "first application" and, as per the present invention, the browser is identified as the "second application".

However, Fig. D illustrates several significant differences compared to that of the presently claimed invention. First, in Fig. D, there must be at least three applications operating on the local machine. This is contrary to that which is claimed in the present invention.

Second, in the hypothetical combination of Nehab, et al. and Davis, et al., the tracker program must operate differently from that described in Davis, et al. in that the results of the tracking program are not returned to some third party server (see, Fig. C), but forwarded to a further application in order to establish the personal profile. This, of itself, creates a conflict with the arrangement described in Nehab, et al. In Nehab, et al., the personal profile is a specific list of URL's or web locations created and desired by the user to be periodically checked so that the contents thereof can be subsequently printed. Accordingly, it is not clear how in any hypothetical combination of Nehab, et al. and Davis, et al. the URL's returned by the tracker program are then converted into a personal profile within the scope of the arrangement described by Nehab, et al.

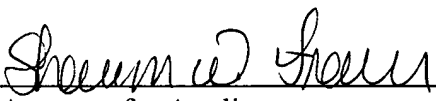For the above reasons, Claim 1 is allowable over the cited art.

While the above argument is specifically addressed to claim 1, the same arguments apply to each of the independent claims of the present application. As a consequence, it is submitted that all independent claims are distinguished from the combination of Nehab, et al. and Davis, et al. and therefore each of the independent claims is allowable.

The dependent claims depend from one or another of the independent claims and are believed allowable for the same reasons. Moreover, each of these dependent claims recite additional features in combination with the features of their respective independent claims and is believed allowable in its own right. Individual consideration of the dependent claims respectfully is requested.

Applicants believe that the present Amendment After Final Rejection is responsive to each of the points raised by the Examiner in the Official Action and submit that the application is in condition for allowance. Favorable consideration of the claims and early passage to issue of the present application earnestly are solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

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